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PATENT APPLICATION

ATTORNEY DOCKET NO. 10007611-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Quintin T. Phillips et al.

Confirmation No.: 6321

Application No.: 09/932,631

Examiner: Myles D. Robinson

Filing Date: August 16, 2001

Group Art Unit: 2625

Title: Image Forming Device Consumable Monitoring Methods, Consumables Monitoring Systems and Image Forming Devices

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on March 13, 2007.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Respectfully submitted,

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By 

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Application Serial No.09/932,631
Filing Date..... August 16, 2001
Inventor..... Quintin T. Phillips et al.
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 2625
Examiner..... Myles D. Robinson
Attorney's Docket No..... PDNO. 10007611-1
Confirmation No..... 6321
Title: Image Forming Device Consumable Monitoring Methods, consumables
Monitoring Systems and Image Forming Devices

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

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Appellant appeals from the Final Office Action mailed December 13, 2006
(hereinafter "Office Action" or "Action"). The Commissioner is authorized to charge
the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

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PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

-i-

TABLE OF CONTENTS

I.	<u>REAL PROPERTY IN INTEREST</u>	1
II.	<u>RELATED APPEALS AND REFERENCES</u>	1
III.	<u>STATUS OF CLAIMS</u>	1
IV.	<u>STATUS OF AMENDMENTS</u>	1
V.	<u>SUMMARY OF CLAIMED SUBJECT MATTER</u>	2
VI.	<u>GROUND OF REJECTION TO BE REVIEWED ON APPEAL</u>	3
VII.	<u>ARGUMENT</u>	3

A. Positively-recited limitations of claims 9-16, 32-33 and 38-40 are not taught nor suggested by Nagata and the 102 rejection is improper.....3

B. Positively-recited limitations of claims 1, 3-8, 24, 26, 30-31, and 34-37 are not taught nor suggested by Nagata and the 102 rejection is improper.....8

C. Positively-recited limitations of claim 12 are not taught nor suggested by Nagata and the 102 rejection is improper.....9

D. Positively-recited limitations of claim 4 are not taught nor suggested by Nagata and the 102 rejection is improper.....10

E. The Office has failed to provide an adequate reason for modifying Nagata in support of the 103 rejection of claim 13 and the reliance upon judicial notice is improper.....11

F. Positively-recited limitations of claim 30 are not taught nor suggested by Nagata and the 102 rejection is improper.....13

G. Positively-recited limitations of claim 32 are not taught nor suggested by Nagata and the 102 rejection is improper.....14

H. Positively-recited limitations of claim 37 are not taught nor suggested by Nagata and the 102 rejection is improper.....15

*PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant*

-ii-

I.	Positively-recited limitations of claim 39 are not taught nor suggested by Nagata and the 102 rejection is improper.....	16
J.	Positively-recited limitations of claim 40 are not taught nor suggested by Nagata and the 102 rejection is improper.....	16
K.	Claims 34-36 particularly point out and distinctly claim the subject matter under 37 CFR 1.75(a).....	17
L.	Conclusion.....	18
VIII.	<u>APPENDIX A – THE CLAIMS INVOLVED IN THIS APPEAL</u>	A-1
IX.	<u>APPENDIX B – EVIDENCE APPENDIX</u>	B-1
X.	<u>APPENDIX C – RELATED PROCEEDINGS</u>	C-1

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

I. REAL PARTY IN INTEREST

The real party in interest of this application is Hewlett-Packard Development Company, L.P. as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 012271, Frame 0898, and the full assignment to Hewlett-Packard Development Company, L.P. recorded starting at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office. The Hewlett-Packard Development Company, L.P., is a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1, 3-16, 24, 26 and 30-40 are pending in this application and claims 2, 17-23, 25, and 27-29 have been canceled. Claims 26, 31, 34-36 and 38 are indicated to recite allowable subject matter. Claims 1, 3-16, 24, 30, 32, 33, 37 and 39-40 stand rejected. Claims 34-36 are objected to. Appellant appeals the rejection of claims 1, 3-16, 24, 30, 32, 33, 37 and 39-40 and the objection to claims 34-36.

IV. STATUS OF AMENDMENTS

No amendments have been filed since the mailing of the Office Action.

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

Referring to Independent claim 1, the specification provides at page 4, line 18 that the consumable monitoring system 16 may store information regarding consumables and proper parties in one embodiment. At step S30 of Fig. 5, information including a consumable identifier and party identifier is received per page 14, line 13. Referring to page 14, line 21, the received consumable identifier is compared with the stored consumable identifiers and the received party identifier is compared with a stored party identifier associated with the consumable and the proper party according to one embodiment. Referring to page 15, line 4, outputting of a message in one embodiment is described.

Referring to dependent claim 4, the forwarding of another message is described in one embodiment at page 15, line 10.

Referring to Independent claim 9, a database is described at page 7, line 16 in one embodiment. An interface is described at page 7, line 7 in one embodiment. Processing circuitry is described at page 7, line 26 in one embodiment.

Referring to dependent claim 12, the forwarding of a warning message is described in one embodiment at page 15, line 10.

Referring to dependent claim 13, forwarding information for storage within a memory device is described at page 13, line 7 according to one embodiment.

Referring to dependent claim 30, the message may indicate the failure to match a party identifier per page 15, line 5 according to one embodiment.

Referring to dependent claim 32, the message may indicate use of the consumable by an unauthorized party per page 15, line 5 according to one embodiment.

Referring to dependent claim 34, the comparing the received consumable identifier and received party identifier is described at page 14, line 21 in one embodiment.

Referring to dependent claim 37, proper parties are described in one embodiment at page 4, line 25.

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

Referring to dependent claim 40, communication to a proper party is described at page 15, line 4 according to one embodiment.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. The 102 rejection of claims 9-16, 32-33 and 38-40 over Nagata.
- B. The 102 rejection of claims 1, 3-8, 24, 26, 30-31, and 34-37 over Nagata.
- C. The 102 rejection of claim 12 over Nagata.
- D. The 102 rejection of claim 4 over Nagata.
- E. The 103 rejection of claim 13 over Nagata and the reliance upon judicial notice.
- F. The 102 rejection of claim 30 over Nagata.
- G. The 102 rejection of claim 32 over Nagata.
- H. The 102 rejection of claim 37 over Nagata.
- I. The 102 rejection of claim 39 over Nagata.
- J. The 102 rejection of claim 40 over Nagata.
- K. The objection of claims 34-36 under 37 CFR 1.75(a).

VII. ARGUMENT

A. Positively-recited limitations of claims 9-16, 32-33 and 38-40 are not taught nor suggested by Nagata and the 102 rejection is improper.

The process of Nagata of Fig. 34 uses the contract signer ID to identify the appropriate spare cartridge table of Fig. 10a which shows the cartridges for the given contract signer in accordance with the contract signer ID per paragraph 0367.

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

Thereafter, Nagata describes determining whether the cartridge is an imitation cartridge at step S45 based upon use of the identified cartridge.

Accordingly, Nagata teaches at Fig. 34 first using the contract signer ID to locate the appropriate spare cartridge table which includes information of the cartridges for the respective contract signer. Then, *after the correct spare cartridge table for the contract signer is located*, Nagata uses the ID of the cartridge received at step S30 to determine whether the cartridge is an imitation.

Claim 9 recites the *processing circuitry configured to compare a received party identifier with a stored party identifier of a respective one of the consumables corresponding to the received consumable identifier*. To the contrary of claim 9 and as is clear from Fig. 34, Nagata first uses the contract signer ID of step S30 to locate the spare cartridge table containing the contract signer ID at paragraph 367 and then *thereafter* at paragraph 368 checks the retrieved table for the status of the cartridge identified by the unique data of the cartridge received in step S30. Accordingly, in the process of Fig. 34, the processing section 122 has no information from the table regarding the consumable until after the contract signer ID is used to locate the appropriate spare cartridge table. There is no evidence that the section 122 again compares the contract signer ID received at step S30 with anything after the table is retrieved and such would be non-sensical inasmuch as *the table for the signer has already been retrieved* and Nagata fails to disclose any further use of the contract signer identification for comparison. When section 122 of Nagata searches and compares the contract signer ID received at step S30 with the contractor IDs associated with the tables, such does not disclose comparing the signer ID received at step S30 with the stored party identifier of the respective consumable corresponding to the received consumable identifier but rather to merely to locate the correct spare cartridge table and thereafter uses the ID of the cartridge to ascertain any stored information regarding the respective cartridge. Accordingly, Appellants respectfully submit Nagata fails to disclose or suggest the *processing circuitry configured to compare the received party identifier with the stored party identifier of a respective one of the consumables corresponding to the received consumable identifier* as claimed. To the contrary, Nagata merely discloses comparison of the contract signer ID with the IDs of the respective spare

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

cartridge tables which fails to teach or suggest the claimed comparison of *the received party identifier with the stored party identifier of a respective one of the consumables corresponding to the received consumable identifier* as claimed.

Appellants respectfully submit that the arguments in the first paragraph of page 3 of the Office Action fail to establish a proper anticipation rejection with respect to the above-described limitations. Appellants respectfully submit that Fig. 34 of Nagata teaches uses of the contract signer ID received at step S30 per paragraph 0366 to locate the appropriate spare cartridge table associated with contract signer and Nagata fails to teach checking the tables to identify the contract signer ID as alleged by the Office. Furthermore, the unique ID data of the toner cartridge received at step S30 per paragraph 0366 is used to identify the specific cartridge once the appropriate table is located and Nagata fails to teach or suggest checking the stored tables to identify the unique ID number of the toner cartridge. Appellants respectfully submit that it is non-sensical to check the stored tables to identify the contract signer ID and unique ID of the cartridge inasmuch as such information is received at step S30 per paragraph 0366. Nagata teaches receiving the contract signer ID and receiving the unique ID of the cartridge at step S30 per paragraph 0366, then locating the appropriate spare cartridge table using the contract signer ID and then using the unique ID of the cartridge to ascertain stored information regarding the cartridge within the previously located table which fails to teach the claimed limitations discussed above.

Appellants respectfully submit that the above recited limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Further referring to claim 9, the processing circuitry is configured to control *outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable* and wherein the communication indicates the *failure of the received party identifier to match the stored party identifier of the respective consumable*. At page 11 of the Action, the Office recites step S45 and the teachings in paragraph 387 of Nagata in support of the rejection. However, as is clear from Fig. 34, at step S45 and as described at paragraphs 369 and 385-387, the warning of paragraph 0387 is displayed

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

responsive to the result of step S33 being "no" to whether the current status is "new(spare)" and the negative response to a condition of whether the current status is "in use" of step S43. The method of Fig. 34 indicates an imitation cartridge at step S45 *responsive to the status of the cartridge* determined at steps S33 and S43. The warning message at step S45 of Fig. 34 responsive to the status of the cartridge fails to disclose or suggest the above-recited limitations including outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable. Indeed, the process of Fig. 34 must and already has *matched the contract signer ID received at step S30 with the contract signer ID associated with the spare cartridge table* retrieved at step S32 before the process can even get to the analysis at steps S33 and S43. Further, Fig. 34 at step S31 fails to accommodate for the condition that the received contract signer ID fails to match one of the contract signer IDs associated with the spare cartridge tables or disclose that any communication results therefrom. Fig. 34 including the outputting of the warning message at step S45 responsive to the status analysis of the cartridge fails to teach or suggest the above-recited claimed limitations of outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable.

At page 4 of the Action in the first full paragraph, the Office baldly states with respect to the Nagata teachings "or in other words, the received data does not match the corresponding stored data." It is clear from Fig. 34 that the mismatch which triggers the warning at step S45 is responsive to status information not matching and not from the specifically claimed outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable.

The Office also relies upon the teachings of Fig. 83, step S56. However, the teachings in Fig. 83 relate to operations of the *image forming apparatus 2* as provided at paragraph 1236 as opposed to the arithmetic processing section 122 of the *service provider 10* executing Fig. 34. The Office has failed to demonstrate how step S56 of Fig. 83 interacts or follows processing of the method of Fig. 34. Further, Applicants have failed to uncover any teachings of Fig. 83 of the claimed

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable. To the contrary, the message at paragraph 1252 of Fig. 83 is in response to the negative print permission message of step S54.

Appellants respectfully submit that limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Nagata also fails to teach or suggest claimed limitations of *the communication indicates the failure of the received party identifier to match the stored party identifier of the respective consumable.* Paragraph 387 of Nagata merely discusses display of an on-screen warning and fails to teach or suggest that *the warning indicates the failure of the received party identifier to match the stored party identifier of the respective consumable as specifically claimed.* Also, the dispatching of the service person at paragraphs 360-362 merely states that an on-screen prompt message and email notification notify the service technician of the situation regarding the status per steps S33 and S43 which fails to teach or suggest *the warning indicates the failure of the received party identifier to match the stored party identifier of the respective consumable as specifically claimed.*

Furthermore, the teachings of Fig. 83 refer to a *print permission message* indicating that the toner cartridge is not proper which fails to teach or suggest *the warning indicates the failure of the received party identifier to match the stored party identifier of the respective consumable as specifically claimed.*

Referring to the first paragraph of page 5 of the Action, the Office provides no evidentiary support from the Nagata teachings that the displayed message "The toner cartridge installed is not proper" is indicative of communicating a mismatch between a received party identifier and stored party identifier. A message stating that the toner cartridge is not proper responsive to an analysis of the status of the cartridge fails to indicate any information regarding a failure of the received party identifier to match the stored party identifier as claimed.

Further referring to the second paragraph of Fig. 5, Appellants have above refuted the assertions of the Office not based upon the teachings of Nagata. Nagata uses the contractor signer ID to locate the correct spare cartridge table and fails to disclose any mechanism for handling the failure to match received and

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

stored party identifiers. Nagata generates warnings at step S45 responsive to the mismatch of status information of the cartridge as being new and in use per steps S33 and S43 and accordingly fails to teach the claimed outputting of the communication responsive to the party identifiers not matching or that the warning indicates the failure of the matching of the party identifiers as positively claimed.

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

B. Positively-recited limitations of claims 1, 3-8, 24, 26, 30-31, and 34-37 are not taught nor suggested by Nagata and the 102 rejection is improper.

At page 14 of the Action, the Office relies upon the teachings of Nagata as applied against claim 9 in support of the rejection of claim 1. Appellants respectfully submit that the 102 rejections are in error.

Claim 1 recites *comparing a received consumable identifier with at least one of the stored consumable identifiers, comparing a received party identifier with at least one of the stored party identifiers, and outputting a message responsive to the comparings*. Step S45 of Fig. 34 of Nagata teaches communications in response to analysis of uses of the consumable at steps S33 and S43. In particular, as disclosed at step S45 and as described at paragraphs 369, and 385-387, the on-screen warning is displayed responsive to the result of step S33 being "no" to whether the current status is "new(spare)" and the negative response to a condition of whether the current status is "in use" of step S43.

Fig. 83 teaches communication of a message in response to a negative print permission message received from the transmitting terminal station of step S54. The teachings of Figs. 34 and 83 fail to teach or suggest the claimed *outputting responsive to the comparing of the received and stored consumable identifiers and the comparing of the received and stored party identifiers*.

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

Appellants respectfully submit that limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Furthermore, claim 1 positively recites *outputting a message to indicate use of the consumable by an unauthorized party*. As set forth in paragraph 0387 of Nagata, step S45 is directed towards investigating a pirated version of a cartridge and fails to provide information regarding an unauthorized party. Indeed, the *party of the method of Fig. 34 is authorized since the method at step S31 located a spare cartridge table corresponding to the party* and Fig. 34 fails to teach not matching a table at step S31 or outputting a message to indicate an unauthorized party. Similarly, the message at paragraph 1252 directed to the toner cartridge not being proper fails to teach or suggest the claimed limitations indicating use by an unauthorized party as claimed.

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

C. Positively-recited limitations of claim 12 are not taught nor suggested by Nagata and the 102 rejection is improper.

Claim 12 recites *the processing circuitry configured to forward a communication comprising a warning message to an image forming device coupled with the consumable to be verified*. The Office at page 13 of the Action in support of the rejection states that the Nagata teachings in paragraphs 1250-1252 and Fig. 83 generically disclose that a message may be displayed but fail to teach that the *message was forwarded to the image forming device* as claimed. Furthermore, the Nagata teachings fail to teach that the *message was forwarded to the image forming device by the processing circuitry of the claimed consumable monitoring system* as claimed.

Appellants respectfully submit that limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

Claim 12 recites in combination with the limitations of claim 9 that the *warning message is forwarded responsive to the comparison of the received and stored consumable identifiers and the received and stored party identifiers*. Per paragraphs 1248-1252, it is clear that the functionality of stopping the printing function of step S56 is provided to the copier by the terminal station of the service provider without teaching or suggesting the *warning message is forwarded responsive to the comparison of the received and stored consumable identifiers and the received and stored party identifiers*.

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

D. Positively-recited limitations of claim 4 are not taught nor suggested by Nagata and the 102 rejection is improper.

Claim 4 recites *forwarding another message comprising a warning message to an image forming device coupled with the consumable to be verified responsive to the comparings*. Paragraphs 1250-1252 and Fig. 83 of Nagata generically disclose that a message may be displayed but fail to teach the claimed *forwarding the another message to the image forming device* as claimed.

Appellants respectfully submit that limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Claim 4 recites in combination with the limitations of claim 1 forwarding the *warning message responsive to the comparings of the received and stored consumable identifiers and the received and stored party identifiers*. Per paragraphs 1248-1252, it is clear that the functionality of stopping the printing function of step S56 is provided to the copier by the terminal station of the service provider without teaching or suggesting the *warning message is forwarded responsive to the comparings of the received and stored consumable identifiers and the received and stored party identifiers*.

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

E. The Office has failed to provide an adequate reason for modifying Nagata in support of the 103 rejection of claim 13 and the reliance upon judicial notice is improper.

In response to Appellants' arguments in the Office Action response dated September 28, 2006, the Office has withdrawn the 102 rejection of claim 13 and now relies upon judicial notice. Appellants now respectfully traverse the reliance upon judicial notice pursuant to MPEP §2144.03 (8th ed., rev. 5).

MPEP 2144.03A (8th ed., rev. 5) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. It is *not appropriate* for the Office to take official notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations of the claimed invention as a whole, and not with respect to the limitations individually.

MPEP 2144.03A (8th ed., rev. 5) provides that *official notice is proper when the facts are capable of instant and unquestionable demonstration as to defy dispute*. MPEP 2144.03A gives examples of limitations which are considered well known, such as when new audio information is recorded then the old information is

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

erased, or when a heat requirement is varied it is well known to vary a flame. The MPEP states that Official Notice is proper when the *teachings are readily verifiable* (e.g., use of a control in bacteriology). MPEP 2144.03B (8th ed., rev. 5). MPEP 2144.03A and 2144.04E make clear that *Official Notice is proper with respect to facts which are of notorious character and serve only to fill in the gaps in an insubstantial manner*. Appellants respectfully assert that the combination of claim 13 reciting the processing circuitry configured to forward the received consumable and party identifiers, and data and time information regarding the reception of the received consumable identifier and the received party identifier to the memory device is not well known in combination with the claimed comparisons of the received and stored consumable and party identifiers as recited in independent claim 9.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

Furthermore, the reason set forth on page 18 for the modification of the Nagata is insufficient. As noted by the USPTO Memorandum dated May 3, 2007 from Margaret A. Focarino (Deputy Commissioner of Patent Operations) interpreting *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), a rejection under 103 should be made explicit and it is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. In particular, under item 4 of the memorandum

The Court noted that the analysis supporting a rejection under 35 U.S.C. §103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often, it will be necessary... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

The Office baldly states at page 18 that the limitations are obvious in order to help predict the upcoming replacement of consumables currently in use. However, the Office has failed to provide any explanation as to how the modification proposed by the Office helps predict the upcoming replacement. Appellants also respectfully submit that the Office has failed to explain how paragraphs 0011-0016 of Nagata are considered to provide the required reason.

Appellants respectfully assert the Office that the reliance upon judicial notice is misplaced and the Office has failed to present a proper reason for modifying Nagata in support of a 103 rejection of the claims.

F. Positively-recited limitations of claim 30 are not taught nor suggested by Nagata and the 102 rejection is improper.

Claim 30 recites the message indicates the failure of the received party identifier to match any stored party identifier associated with the consumable to be verified. At page 15 of the Action, the Office relies upon Fig. 34 and Fig. 83 of Nagata. Fig. 34 teaches the formulating the message responsive to analyses of use of the cartridge after the received *contractor signing ID matches the contractor ID of the spare cartridge table* accessed at step S31. Accordingly, Fig. 34 teaches matching the contractor signing ID at S31 and the message of S45 fails to teach the claimed message indicates the failure of the received party identifier to match any stored party identifier associated with the consumable to be verified.

The message at paragraph 1252 and Fig. 83 of Nagata is in response to a negative print permission message being received at step S54 and indicates that the toner cartridge is not proper. Fig. 83 fails to teach or suggest the claimed *message*

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

indicates the failure of the received party identifier to match any stored party identifier associated with the consumable to be verified.

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

G. Positively-recited limitations of claim 32 are not taught nor suggested by Nagata and the 102 rejection is improper.

Referring to claim 32, the *communication of claim 9 indicates use of the consumable by an unauthorized party*. The Office at pages 14-15 of the Action relies upon the teachings in paragraph 387 of Nagata in support of the rejection. However, the generic on-screen warning of paragraph 387 fails to teach or suggest the claimed communication indicates use of the consumable by an unauthorized party. Furthermore, the message of paragraph 1252 relates to a message stating "The toner cartridge installed is not proper. Please replace it with a proper toner cartridge" which fails to teach or suggest the claimed communication indicating use of the consumable by an unauthorized party. Referring to page 7 of the Action, step S45 of Nagata of merely notifying the service provider and dispatching the service person to investigate are responsive to the analysis of the use condition of the consumable and the Office has failed to provide any rationale as to how such teachings disclose the claimed communication indicating use of the consumable by an unauthorized party. The imitation consumable possibly discovered at step S45 shows that the consumable is improper and not use of a consumable by an unauthorized party as claimed. Further, the party is authorized as indicated by the location of a table for the party at step S31.

Referring to page 8 of the Action, Appellants respectfully submit that Nagata fails to teach the received party identifier not matching the consumable party identifier recited in claim 9 in combination with the other limitations. Appellants respectfully submit that the further reliance on page 8 of the Action of the faulty

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

analysis of the Nagata teachings illustrates the improper nature of the rejection. Nagata teaches the communication stating that the toner cartridge is not proper which does not teach or suggest the claimed limitations of the communication indicating use of the consumable by an unauthorized party as specifically claimed.

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

H. Positively-recited limitations of claim 37 are not taught nor suggested by Nagata and the 102 rejection is improper.

The teachings of Nagata including Fig. 34 are directed towards identifying pirated or imitation cartridges in the system of managed copiers of Nagata. The consumables which are identified in step S45 are suspected to be *pirated or imitation consumables*. Appellants respectfully submit Nagata fails to teach or suggest the limitations of the proper party is entitled to use the consumable to be verified since no contract signers of the system of Nagata are entitled to use imitation or pirated consumables. Furthermore, Appellants have failed to uncover any teachings in Nagata that the communicated message regarding use of improper toner cartridges of Nagata discloses the claimed *outputting the message to indicate use of the consumable to be verified by the unauthorized party different than the proper party who is entitled to use the consumable to be verified*. Appellants have failed to uncover any teachings of the contract signers of Nagata being authorized to use pirated cartridges which are discovered at step S45 of Fig. 34.

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

I. Positively-recited limitations of claim 39 are not taught nor suggested by Nagata and the 102 rejection is improper.

The claim 39 recites *that the non-matching received party identifier and the stored party identifier identify different parties*. The Office relies upon the teachings of Fig. 83 in support of the rejection. Step S54 of Fig. 83 of Nagata merely awaits the print permission message void of reference to verified and properly registered users. The teachings of Fig. 83 fail to teach or suggest the limitations *that the non-matching received party identifier and the stored party identifier identify different parties* when properly considered in combination with the claimed limitations of claim 9 reciting the processing circuitry configured to control outputting of the communication responsive to the received and stored party identifiers not matching and the communication indicates the failure of the received and stored party identifiers to match.

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

J. Positively-recited limitations of claim 40 are not taught nor suggested by Nagata and the 102 rejection is improper.

Claim 40 recites the processing circuitry configured to *communicate the communication to the proper party* in combination with limitations of claim 9 which states that the stored party identifier is utilized to identify a *proper party associated with the respective consumable*. The teachings of Fig. 34 of Nagata with respect to the service person and the display on the copier of Fig. 83 fail to teach or suggest communication to a proper party identified by the stored party identifier and as being associated with the respective consumable.

Appellants respectfully submit that above-recited limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

Furthermore, the claim recites that the communication communicated to the proper party comprises the received party identifier corresponding to the unauthorized party different than the proper party. Nagata discloses identifying imitation cartridges at Fig. 34 by monitoring the use of the cartridge and fails to provide teachings of the claimed communication including the received party identifier corresponding to an unauthorized party different than the proper party as explicitly claimed.

Appellants respectfully submit that numerous limitations of the claims are not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

Appellants respectfully submit that the rejection of the claims is improper for the above-mentioned reasons and Appellants respectfully request reversal of the rejections.

K. Claims 34-36 particularly point out and distinctly claim the subject matter under 37 CFR 1.75(a)

Claims 35 and 36 depend from claim 34 which depends from claim 1. Claim 1 recites storing information regarding a plurality of consumables, and the stored information *for an individual one of the consumables* includes a stored consumable identifier. Accordingly, claim 1 recites that the storing information comprises storing stored consumable identifiers for the plurality of consumables. Claim 1 further recites comparing the received consumable identifier with at least one of the stored consumable identifiers. Appellants respectfully submit that claim 34 further clearly limits the comparing the received consumable identifier act of claim 1 by stating that such comparing comprises comparing the received consumable identifier with a plurality of *the stored consumable identifiers* defined in claim 1. In particular, the claim clarifies that the at least one language of claim 1 means comparing the received consumable identifier with a plurality of the stored consumable identifiers.

Appellants respectfully submit that the claims sufficiently point out and distinctly that Appellant is referring to the same stored consumable identifiers of claim 1 since claim 34 recites the comparing the received consumable identifier

PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

18

with a plurality of the stored consumable identifiers which clearly refers to the stored consumable identifiers of claim 1.

Appellants request reversal of the objection to the claims for at least the above-mentioned reasons.

L. Conclusion

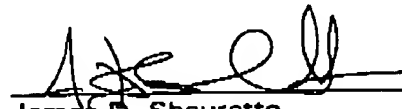
In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of the claims.

Respectfully submitted,

Date:

5/14/07

Attorney:


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PDNO. 10007611-1
Serial No. : 09/932,631
Brief of Appellant

A-1

VIII. APPENDIX A - THE CLAIMS INVOLVED IN THIS APPEAL

1 1. [Previously Presented] An image forming device consumable
2 monitoring method comprising:
3 storing information regarding a plurality of consumables usable to form
4 hard images, wherein the stored information for an individual one of the
5 consumables includes a stored consumable identifier which identifies the
6 respective consumable and a stored party identifier utilized to identify a proper
7 party of the respective consumable;
8 receiving information regarding a consumable to be verified including a
9 received consumable identifier which identifies the consumable to be verified
10 and a received party identifier utilized to identify the proper party associated
11 with the consumable to be verified;
12 comparing the received consumable identifier with at least one of the
13 stored consumable identifiers;
14 comparing the received party identifier with at least one of the stored
15 party identifiers; and
16 outputting a message responsive to the comparings to indicate use of the
17 consumable to be verified by an unauthorized party who is not authorized to use
18 the consumable.

1 3. [Original] The method of claim 1 further comprising forwarding a
2 command to an image forming device coupled with the consumable to be
3 verified to disable at least one operation of the image forming device coupled
4 with the consumable to be verified responsive to the comparings.

1 4. [Previously Presented] The method of claim 1 further comprising
2 forwarding another message comprising a warning message to an image forming
3 device coupled with the consumable to be verified responsive to the comparings.

1 5. [Original] The method of claim 1 further comprising recording the
2 received consumable identifier, the received party identifier, and date and time
3 information regarding the reception of the received information.

PDNO. 10007611-1
Serial No. 09/932,631
Brief of Appellant

A-2

1 6. [Original] The method of claim 1 wherein the receiving the
2 received party identifier comprises receiving a received device identifier which
3 identifies the image forming device which communicated the information and
4 wherein the storing comprises storing the stored party identifier comprising at
5 least one stored device identifier which identifies an image forming device
6 associated with the proper party for the respective consumable and wherein the
7 comparing the received party identifier comprises comparing the received device
8 identifier with the stored device identifier.

1 7. [Original] The method of claim 6 wherein the storing the stored
2 party identifier comprises storing a plurality of stored device identifiers and the
3 comparing the received party identifier comprises comparing the received device
4 identifier with the plurality of stored device identifiers.

1 8. [Original] The method of claim 1 wherein the receiving the
2 received party identifier comprises receiving the received party identifier which
3 directly identifies the proper party of the respective consumable.

1 9. [Previously Presented] A consumable monitoring system
2 comprising:
3 a database configured to store information regarding a plurality of
4 consumables usable to form hard images, wherein the stored information for an
5 individual one of the consumables includes a stored consumable identifier which
6 identifies the respective consumable, and a stored party identifier utilized to
7 identify a proper party associated with the respective consumable;
8 an interface adapted to receive information regarding a consumable to be
9 verified including a received consumable identifier which identifies the
10 consumable to be verified and a received party identifier utilized to identify the
11 proper party associated with the consumable to be verified;
12 processing circuitry configured to compare the received consumable
13 identifier with the stored consumable identifiers and to compare the received
14 party identifier with the stored party identifier of a respective one of the
15 consumables corresponding to the received consumable identifier; and

PDNO. 10007611-1
Serial No. 09/932,631
Brief of Appellant

A-3

16 wherein the processing circuitry is configured to control outputting of a
17 communication responsive to the received party identifier not matching the
18 stored party identifier of the respective consumable and wherein the
19 communication indicates the failure of the received party identifier to match the
20 stored party identifier of the respective consumable.

1 10. [Previously Presented] The system of claim 9 wherein the
2 processing circuitry is configured to forward the communication comprising a
3 message to the proper party associated with the respective consumable
4 responsive to the comparisons.

1 11. [Previously Presented] The system of claim 9 wherein the
2 processing circuitry is configured to forward the communication comprising a
3 command to disable at least one operation of an image forming device coupled
4 with the consumable to be verified responsive to the comparison.

1 12. [Previously Presented] The system of claim 9 wherein the
2 processing circuitry is configured to forward the communication comprising a
3 warning message to an image forming device coupled with the consumable to
4 be verified responsive to the comparison.

1 13. [Original] The system of claim 9 further comprising a memory
2 device, and wherein the processing circuitry is configured to forward the
3 received consumable identifier, the received party identifier, and date and time
4 information regarding the reception of the received consumable identifier and the
5 received party identifier to the memory device for storage.

1 14. [Previously Presented] The system of claim 9 wherein the
2 interface is adapted to receive the information regarding the consumable to be
3 verified including the received party identifier comprising a received device
4 identifier which identifies the image forming device which communicated the
5 information and wherein the database is configured to store the stored party
6 identifiers comprising at least one stored device identifier which identifies an

PDNO. 10007611-1
Serial No. 09/932,631
Brief of Appellant

A-4

7 image forming device associated with the proper party for the respective
8 consumable and wherein the processing circuitry is configured to compare the
9 received device identifier with the stored device identifier to compare the
10 received party identifier with the stored party identifier.

1 15. [Previously Presented] The system of claim 9 wherein the
2 database is configured to store the stored party identifier comprising a plurality
3 of stored device identifiers which identify a plurality of image forming devices
4 associated with the proper party of the respective consumable, and wherein the
5 processing circuitry is configured to compare the received party identifier
6 comprising a received device identifier with the stored device identifiers.

1 16. [Original] The system of claim 9 wherein the interface is adapted
2 to receive the information regarding the consumable to be verified including the
3 received party identifier which directly identifies the proper party of the
4 respective consumable.

1 24. [Previously Presented] The method of claim 1 wherein the
2 outputting comprises outputting the message to an owner of the respective
3 consumable.

1 30. [Previously Presented] The method of claim 1 wherein the
2 message indicates the failure of the received party identifier to match any stored
3 party identifier associated with the consumable to be verified.

1 32. [Previously Presented] The system of claim 9 wherein the
2 communication indicates use of the consumable to be verified by an
3 unauthorized party.

1 33. [Previously Presented] The system of claim 32 wherein the
2 processing circuitry is configured to address the communication for
3 communication to the proper party and to control outputting of another

PDNO. 10007611-1
Serial No. 09/932,631
Brief of Appellant

A-5

4 communication comprising a warning message of unauthorized use to an image
5 forming device coupled with the consumable to be verified.

1 37. [Previously Presented] The method of claim 1 wherein the proper
2 party is entitled to use the consumable to be verified and the unauthorized party
3 is a party different than the proper party.

1 39. [Previously Presented] The system of claim 9 wherein the non-
2 matching received party identifier and the stored party identifier identify different
3 parties.

1 40. [Previously Presented] The system of claim 9 wherein the
2 processing circuitry is configured to communicate the communication to the
3 proper party and wherein the communication comprises the received party
4 identifier corresponding to an unauthorized party different than the proper party.

PDNO. 10007611-1
Serial No. 09/932,631
Brief of Appellant

B-1

IX. APPENDIX B – EVIDENCE APPENDIX

Appellants submit no evidence with the appellate brief.

*PDNO. 10007611-1
Serial No. 09/932,631
Brief of Appellant*

C-1

X. APPENDIX C - RELATED PROCEEDINGS

Appellants are not aware of any related proceedings.

*PDNO. 10007611-1
Serial No. 09/932,631
Brief of Appellant*